

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/679,054 10/03/00 DORSCHNER

A BEIERSDORF

HM22/1106
NORRIS, MCLAUGHLIN & MARCUS, P.A.
220 EAST 42ND STREET
30TH FLOOR
NEW YORK NY 10017

EXAMINER

LAMM, M

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1616

DETAILED ACTION

Acknowledgment is made of the amendment filed 9/20/01. Claims pending are 5-11.

Claims 1-4 have been cancelled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 9, 10 are viewed as indefinite because they depend on Claim 1 which was cancelled by the amendment.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 5 recites the broad

Art Unit: 1616

recitation “emulsifiers not covered by the definition of emulsifier A”, and the claim also recites “ in particular those which act primarily as W/O emulsifiers” which is the narrower statement of the range/limitation.

Claim 5 is also viewed as indefinite because it recites the limitation “chosen from the group of emulsifiers not covered by the definition of emulsifier A.” It is unclear what emulsifiers are encompassed by this limitation. The language used by the applicant presents uncertainty with respect to the question of scope of the claim. In response to the Applicant’s request, the Examiner of record would suggest the following claim language: “emulsifiers selected from the group consisting of [list of emulsifiers].”

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 5-11 are rejected under 35 U.S.C. 102(e) as being anticipated by either Kaplan or McShane et al.

Kaplan teaches oil-in-water sunscreen compositions containing 0.05-20% of emulsifiers such as PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, etc., and up to 15% of insect repellents such as DEET. See col. 1, line 50; col. 4, lines 36-65; col. 5, lines 25-29; col. 6, lines 42-62. The composition of Kaplan may contain 1-10% of glycerin or polymeric glycols. See col. 6, lines 5-12.

McShane et al. teach sunscreen oil-in-water emulsions containing 0.05-20% of at least one emulsifier (e.g. PEG-45/ dodecyl glycol copolymer, polyglyceryl-3-diisostearate, sorbitan trioleate, cetareth-15) and up to 15% of an insect repellent such as DEET. See Abstract; col.

Art Unit: 1616

5, lines 2-4, 29-60; col. 6, lines 4-8; col. 7, lines 31-53. The composition of McShane et al. may contain 1-10% of glycerin or other glycols. See col. 6, lines 52-58.

Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the emulsifiers disclosed in the references.

Thus, Kaplan or McShane et al. teach each and every limitation of Claims 5-11.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al.

Hart et al. teach oil-in-water emulsions containing insect repellents, such as N,N-diethyl-m-toluamide, propylene glycol and nonionic emulsifiers such as polyoxyethylene stearate and oleate, polyethoxylated cetyl alcohol, mono-, di- and tri- esters of various polyols, glycerol monostearate, sorbitan tristearate and sorbitan dioleate, in the claimed concentrations. See Abstract; col. 3, lines 4, 23-30; col. 10, Example VI. Propylene glycol is a known functional equivalent of glycerin.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use glycerin instead of propylene glycol of Hart et al. for its art-recognized purpose and with a reasonable expectation of deriving the same cosmetic results as set forth in the reference.

Art Unit: 1616

7. Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Randen or Knowles, Jr. et al. or Thomas et al. in view of either Kaplan or McShane et al.

Randen teaches mosquito repellent compositions which can be prepared as oil-in-water emulsions, comprising 1-10% of oil-in-water emulsifying agents such as cetareth-20, glyceryl monostearate, and 10-70% of DEET. See col. 6, line 63; col. 7, lines 30-40; col. 9, Examples. The compositions of Randen may contain polyethylene glycol. See Examples.

Knowles, Jr. et al. teach sunscreen/insect repellent compositions which can be prepared as oil-in-water emulsions, comprising 0.01-10% of an emulsifying agent such as glyceryl hydroxystearate and 0.5-95% of DEET. See col. 2, lines 35-43; col. 3, lines 29, 54-55; col. 5, Example 2.

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants and 0.5-20% of insect repellents such as DEET. See Abstract; col. 4, lines 1-7; col. 5, lines 33-34.

Applicant's functional language regarding the properties of the emulsifiers A would have been inherent to the emulsifiers disclosed in the references.

Neither reference teach glycerin of the instant claims.

However, Kaplan or McShane et al. teach using humectants such as glycerin or other polyols in their sunscreen and insect repellent compositions as discussed above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use glycerin of Kaplan or McShane et al. in compositions of Randen, Knowles, Jr. et al. or Thomas et al. for its art-recognized purpose and with a reasonable expectation of beneficial results such as skin moisturizing effect.

Art Unit: 1616

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Application/Control Number: 09/679,054

Page 7

Art Unit: 1616

ml

11/2/01

JOSE G. DEES
SUPERVISORY PATENT EXAMINER